THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DALE L. BODIAN, JUDITH M. WHITE, IRWIN D. KUNTZ,
JAY F. STEARNS and R. BRYAN YAMASAKI

_____

Appeal No. 95-1364
Application No. 07/919,287[1]

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ON BRIEF

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Before JOHN D. SMITH, SCHAFER and OWENS, Administrative Patent Judges.

SCHAFER, Administrative Patent Judge.

DECISION ON APPEAL

Applicants appeal the final rejection claims 1-6, 8-9, 12-17, and 23-36. We have jurisdiction pursuant to 35 U.S.C. § 134.

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[1] Application for patent filed July 24, 1992.

Background

The subject matter of the invention is a medical method. In particular, the claims are directed to a method for treating a viral condition caused by an enveloped virus. According to the specification

> [e]nveloped viruses include a fusion protein that changes conformation from a native form to a fusogenic form. This promotes fusion of the viral membrane with the host cell membrane, resulting in injection of viral contents into the host cell.

Specification, p. 1, lines 19-22. Applicants list the following families of viruses as enveloped viruses:

> Togaviridae, Flaviviridae, Coronaviridae, Rhabdoviridae, Filoviridae, Paramyxoviridae, Orthmyxoviridae, Bunyaviridae, Arenaviridae, Retroviridae, Hepadnaviridae, Herpesviridae, Poxviridae and Iridoviridae.

Specification, p. 4, lines 31 - 34. The conditions which can be treated using the invention are said to include

> rubella, yellow fever, rabies, influenza, Korean hemorrhagic fever, common colds, respiratory syncytial virus, measles, mumps, HIV, hepatitis B, Herpes simplex, CMV, chicken pox, smallpox, Marburg virus, hemorrhagic fever, Lassa fever and African swine fever.

Specification, p. 4, line 34 - p. 5, line 4.

According to applicants the viral condition is treated by administering a therapeutically effective amount of a substituted benzene compound to the patient. The substituted benzene compound is generically defined as a benzene compound comprising a 2-R^1, 3-R^2-1-OX^1, 4-OX^2 where at least one of R^1 and R^2 include a carbon linkage to the benzene ring and OX^1 and OX^2 are simultaneously hydroxy. See Claim 1. Applicants' specification also tells us that the treatment is effective because the compound inhibits fusion of the viral membrane with the cell's endosomal membrane by binding near the stem region or the hinge region of the virus' hemagglutinin glycoprotein. The bound compound reduces the ability of the fusion protein to adopt the fusogenic conformation. Specification, p. 1, line 31 - page 4, line 19.

Independent claims 1, 14, 23 and 26 are representative (Appendix of claims, p. 1-3):

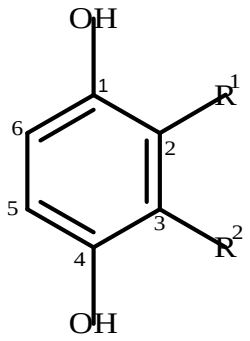
1. A method of treating a viral condition caused by an enveloped virus, said method comprising using a therapeutically effective amount of a compound selected from the group consisting of a substituted benzene, wherein said benzene comprises a 2-R^1, 3-R^2-1-OX^1, 4-OX^2 compound where at least one of R^1 and R^2 include a carbon linkage to the benzene ring and OX^1 and OX^2 are simultaneously hydroxy.

14. A method of treating a viral condition caused by an enveloped virus, said method comprising using a therapeutically effective amount of a compound having an IC_{50} of less than 10^{-3} M in the INF assay, wherein said compound comprises a substituted benzene, wherein said benzene comprises a 2-R^1, 3-R^2-1-OX^1, 4-OX^2 compound where at least one of R^1 and R^2 include a carbon linkage to the benzene ring and OX^1 and OX^2 are simultaneously hydroxy.

23. A method of treating a viral condition caused by an enveloped virus, said method comprising using a therapeutically effective amount of a compound which binds near the hinge region or near the stem region of hemagglutinin.

26. A method of treating a viral condition wherein the viral condition is caused by a virus having a fusion protein which has a native, non-fusogenic conformation and a second, fusogenic conformation, the method comprising using a therapeutically effective amount of a compound which binds to the fusion protein in the native conformation and reduces the ability of the fusion protein to adopt the fusogenic conformation.

As we understand the subject matter of claims 1 and 14, the substituted benzene compound set forth in these claim is represented by the following structural formula:



In other words, claims 1 and 14 as we understand them, require that 2-R^1, 3-R^2-1-OX^1, and 4-OX^2 substituents must all to be present on the benzene ring simultaneously. We have indicated the ring positions (1-6) according to standard benzene ring nomenclature. 1-OX^1 and 4-OX^2 have been indicated as hydroxy (OH) since claims 1 and 14 each require that "OX^1 and OX^2 are simultaneously hydroxy."

Applicants further define R^1 and R^2 at page 11 of their specification:

> More generally, R^1 and R^2 each can be a hydrocarbon, saturated or unsaturated, potentially aromatic, generally hydrophobic, up to about C_{10}, but R^1 and R^2 taken together should include at least two carbon atoms. R^1 or R^2 or both can be electron donating or slightly electron withdrawing, e.g. -CH_2-O-CH_3, CH_2O-R^3 (where R^3 is a generally hydrophobic hydrocarbon, saturated or unsaturated, potentially aromatic, up to about C_{10}) or -CH^2-COOH or esters thereof. R^1 and R^2 cannot both be strongly electron withdrawing, e.g. halogen or nitrile. R^1 and R^2 are preferably hydrophobic. R^1 and R^2 can be part of a carbocyclic structure, e.g. naphthoquinone or compound 83, but should not be part of a highly polar heterocycle. Such a carbocyclic structure may be saturated, unsaturated, or aromatic. Preferably R^1, and R^2 if present, should have a carbon residue in the position "- to the 1,4-dihydroquinone ring.

We also note that claims 23 and 26 define the invention in terms of a step (e.g., "using a therapeutically effective amount of a compound" coupled with a function (e.g., " which binds near the hinge region or near the stem region of hemagglutinin").

The examiner asserts several grounds of rejection:

1. The subject matter of claims 1, 5-6, 8-9, 14-16, 26-27 and 31-36 is rejected under 35 U.S.C. § 101 as failing to be a useful process;
2. The subject matter of claims 23-25 is rejected under 35 U.S.C. § 101 as failing to be a useful process;

3. The subject matter of claims 13-15 and 23-30 is rejected under 35 U.S.C. § 112, ¶ 1, as failing to be supported by an enabling disclosure;

4. The subject matter of claims 1, 5-9, 12-15, 21, 23-28 and 31-36[2] is rejected under 35 U.S.C. § 112, ¶ 1, as including subject matter which is not supported by an enabling disclosure;

5. The subject matter of claims 1-6, 8-9, 13-17, 21, 30, and 31-36 is rejected under 35 U.S.C. § 102(b) as anticipated by either of the following references:

Chemical Abstract 73:129328z	Bogdanova et al. (Bogdanova)	1970
Chemical Abstract 85:56546e	Grinev et al. (Grinev)	1976

6. The subject matter of claims 1-6, 8-9, 12-17 and 23-26 is rejected under 35 U.S.C. § 103 as unpatentable over the combination of Bogdanova and Grinev and the following references:[3]

Chemical Abstract 84:160055j	Thiel et al. (Thiel)	1976
U S Patent 4,898,891	Lavie et al. (Lavie)	February 6, 1990

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[2] This rejection was actually expressed by the examiner as two separate rejections. Claims 34-36 were subject to only one of the two rejections. Because of our disposition of the rejections we do not have to distinguish between the two grounds.

[3] We note that the examiner's statement and discussion of the rejection refers to a Leach et al. reference. Examiner's Answer, p. 8. However, this reference is not listed on page 2 of the Answer setting out the prior art relied upon, a copy of the reference could not be located in the record, nor were we able to find it listed on the PTO Forms 892 and 1449 of record.

Soviet Union Inventor's Certificate 923,028	Ordzhokikidze Chem-Pharm (Ordzhokikidze)	February 23, 1983
Chemical Abstract 96:199209k	Korsakova et al. (Korsakova)	1982
Chemical Abstract 115:231795	Lyubchanskaya et al. (Lyubchanskaya)	1991

Disposition

We reverse the rejections based on 35 U.S.C. §§ 101 and 112; vacate the rejections under 35 U.S.C. § 102(b) and 103 and remand the application for further examination on these grounds; and enter a new ground of rejection under 35 U.S.C. §112, ¶ 2.

Analysis

The Burden of proof

In proceedings before the PTO the examiner has the burden of establishing the prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). To meet this burden the examiner must present a factual basis supporting the conclusion that a prima facie case exists. See In re Freed, 425 F.2d 785, 787, 165 USPQ 570, 571 (CCPA 1970); In re Warner, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967); In re Lunsford, 357 F.2d 385, 391, 148 USPQ 721, 725 (CCPA 1966).

The rejections under 35 U.S.C. § 101

With respect to the so called utility requirement of 35 U.S.C. § 101, the CCPA has described the requirements for establishing a prima facie case of lack of utility:

> As a matter of Patent Office practice, a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of § 101 for the entire claimed subject matter unless there is reason for one skilled in the art to question the objective truth of the statement of utility or its scope. Assuming that sufficient reason to question the statement of utility and its scope does exist, a rejection for lack of utility under § 101 will be proper on that basis; such a rejection can be overcome by suitable proofs indicating that the statement of utility and its scope as found in the specification are true. [Emphasis added.]

In re Langer, 503 F.2d 1380, 1391-92, 183 USPQ 288, 297 (CCPA 1974).

Rejection of claims 1, 5-6, 8-9, 14-16, 26-27 and 31-36

There is no assertion raised that the utility disclosed in the specification fails to correspond to the scope of the claimed subject matter. Indeed, the specification expressly states the utility as "treating a viral condition caused by an enveloped virus." Specification, p. 4, lines 21-22. This is the same utility as set forth in the claims. Thus, the stated utility must be considered sufficient unless the examiner presents evidence and reasoning which would give one having ordinary skill in the art reason to doubt the objective truth of the application's statement of utility.

The examiner correctly notes that many of the claims read on treating AIDS. The examiner asserts that "[t]reatment efforts, and efforts to cure this group of related symptoms have produced no identifiable positive results." Examiner's answer, p. 3. However, the examiner has not provided any evidence which supports this assertion. The examiner's reliance on Ex parte Balzarini, 21 USPQ2d 1892 (Bd. Pat. App. & Interferences 1991), a non-precedential opinion of this board, does not help the examiner's position. In Balzarini the examiner provided ample evidence to support the position that those skilled in the art would not believe that successful in vitro testing would be a reasonable basis for predicting in vivo efficacy. This

evidence included publications which were contemporaneous with and subsequent to Balzarini's 1987 filing date. Here the examiner has not provided any evidence to support the asserted lack of utility. The Balzarini opinion itself cannot serve as relevant evidence as to how the asserted utility would be judged by those working in the art when the application was filed in 1992. At best, Balzarini indicates what those skilled art would have believed in 1987 as to predictability from in vitro tests. However, Balzarini does not create a per se rule of lack of utility for all AIDS-related inventions. In making a rejection for lack of utility it is the examiner's burden to provide evidence showing that those working in the art would not believe the objective truth of the stated utility at the time the application was filed. Langer, 503 F.2d at 1391-92, 183 USPQ at 297. Such evidence is lacking here and the examiner has failed to make out a prima facie case for lack of utility.

Because we hold that the examiner has not made out a prima facie case, it is not necessary for us to address the White declaration with respect to this ground of rejection.

The rejection of claims 1, 5-6, 8-9, 14-16, 26-27 and 31-36 under 35 U.S.C. § 101 is reversed.[4]

Rejection of claims 23-25

The examiner rejects these claims on a different theory. In the examiner's view the claims read on effecting various biochemical pathways and as such do not set forth a viable utility. Examiner's Answer, p. 5. The examiner asserts that

> [u]nless the pathway at issue is critical to treating some condition, and the pathway modification and disease treatment are inexorably linked, such pathway modification is devoid [of] utility. . . . The skilled artisan could affect a biochemical

[4] Our reversal of this rejection should not be construed as an indication that we are questioning the truth of the examiner's statement that "[t]reatment efforts, and efforts to cure this group of related symptoms have produced no identifiable positive results." The examiner may very well be right on this point. However, the examiner must provide evidence to prove this assertion.

> pathway, in a patient without producing any therapeutic benefit or physiologically detectable effect.

Examiner's Answer, p. 6.

We do not agree with the examiner's implicit position that claims which read on affecting biochemical pathways necessarily do not set forth a viable utility. We know of no such per se rule. It may be that, based on appropriate evidence, claims directed to effecting biochemical pathways can be held to lack utility. However, we do not have to make that determination in this appeal because the rejected claims set forth a utility not just a pathway. Claim 23 specifically states that the method is for "treating a viral condition . . . using a therapeutically effective amount of a compound . . . ." "Viral condition" is defined in the specification as

> rubella, yellow fever, rabies, influenza, Korean hemorrhagic fever, common colds, respiratory syncytial virus, measles, mumps, HIV, hepatitis B, Herpes simplex, CMV, chicken pox, smallpox, Marburg virus, hemorrhagic fever, Lassa fever and African swine fever.

Specification, p. 4, line 34 - p. 5, line 4. The claim also requires the use of a "therapeutically effective amount" of the compound. This phrase requires that the compound have a beneficial effect on a viral condition such as influenza. The claim does not encompass affecting a biochemical pathway without producing a therapeutic benefit or physiologically detectable effect as asserted by the examiner.

Additionally, as with claims 1, 5-6, 8-9, 14-16, 26-27 and 31-36, the examiner has failed to support the holding of lack of utility with any evidence which would present doubts as to the objective truth of the statements of utility in the specification and claims.

The rejection of claims 23-25 under 35 U.S.C. § 101 is reversed.

The rejections under 35 U.S.C. 112, ¶ 1

The standards for establishing a prima facie case of lack of enablement is similar to that for lack of utility:

> [A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of Section 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

Fiers v. Revel, 984 F.2d 1164, 1171-72, 25 USPQ2d 1601, 1607 (Fed. Cir. 1993) quoting In re Marzocchi , 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971).

The specification, when filed, must enable one skilled in the particular art to use the invention without undue experimentation. In re Goodman, 11 F.3d 1046, 1050, 29 USPQ2d 2010, 2013 (Fed.Cir. 1993); In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The specification must provide enablement as broadly as the invention is claimed. Goodman, 11 F.3d at 1050, 29 USPQ2d at 2013, In re Vaeck, 947 F.2d 488, 496, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991)

The rejection of claims 13-15 and 23-30 under 35 U.S.C. 112, ¶ 1

The examiner has objected to the specification under 35 U.S.C. § 112, ¶ 1, concluding that the specification does not enable one having ordinary skill in the art to make and use the claimed invention. Claims 13-15 and 23-30 were rejected under 35 U.S.C. § 112, ¶ 1, for the reason set forth in the objection to the specification.

The examiner has failed to demonstrate that the applicants' disclosure does not contain a teaching of the manner and process of using the claimed invention in terms which correspond in scope to the terms used in describing the invention. Thus, the examiner has the burden of providing evidence or reasoning to establish a basis to challenge the objective truth of the statements in the specification. Fiers, 984 F.2d at 1172, 25 USPQ2d at 1607. In the examiner's view certain critical information is missing from the disclosure. The examiner notes:

> Applicants claim a group of compounds that possess a specific utility, yet fail to set forth the test or the compounds that might fit the test criteria. Claims to preventing disease conditions are presented, yet Applicant fails to provide information that

> would enable the skilled artisan to identify individuals in need of such preventive treatment. The instant invention proposes treating viral etiological agents embodying "a fusion protein which has a native, non-fusogenic conformation and a second, fusogenic conformation", yet fails to fails to [sic] provide information that would enable the skilled artisan to identify the specific etiological agents treatable by the claimed antiviral method.

Examiner's Answer p. 6-7. However, the absence of information from the specification is not a basis, alone, for concluding that the specification in not enabling. The examiner must also establish that because of the missing information, one having ordinary skill in the art would not be able to make and use the claimed invention without undue experimentation. The examiner has not met that burden in this case. The examiner has not provided any evidence which would allow us to hold that undue experimentation would be necessary to practice the claimed invention. For all the record shows, the alleged missing information is within the level of ordinary skill in the art. Such information need not be disclosed in the specification. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); Lindemannn Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). Indeed, the specification preferably omits, that which is well known in the art. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); Lindemannn, 730 F.2d at 1463, 221 USPQ at 489.

The rejection of claims 13-15 and 23-30 is reversed.

The rejection of claims 1, 5-9, 12-15, 21, 23-28 and 31-36

The examiner rejects claims 1, 5-9, 12-15, 21, 23-28 and 31-36 under 35 U.S.C. § 112, ¶ 1, holding that the subject matter is broader than the enabling disclosure. The examiner asserts that the subject matter of claims 1, 5-9, 12-15, 21, 23-28 and 31-33 are enabled only as to the specific viral etiologic agents named in the specification. The examiner also asserts that the subject matter of claims 1, 5-9, 12-15, 21, 23-28 and 31-36 is enabled only as to the specifically named antiviral compounds. Examiner's Answer, p. 7.

As we indicated above, the examiner has the burden of proof. The examiner must provide evidence or reasoning tending to show that the person of ordinary skill in the art could not practice the invention with unexemplified compounds and etiological agents within the scope of the claims without undue experimentation. The examiner has not met that burden. The examiner has presented no evidence or reasoning tending to show that undue experimentation would be necessary.

The examiner notes that the disclosure as filed does not include an "OX" compound as required by, for example, by claims 1 and 14. However, these claims expressly require OX^1 and OX^2 to be OH thus limiting these claims to hydroquinone derivatives. The examiner has not provided any evidence which establishes that the person having ordinary skill in the art would not be able to practice the claimed invention using hydroquinone derivatives without undue experimentation.

The rejection of claims 1, 5-9, 12-15, 21, 23-28 and 31-36 under 35 U.S.C. § 112, ¶ 1, is reversed.

The prior art rejections

The rejection of claims 1-6, 8-9, 13-17, 30, and 31-36 under 35 U.S.C. § 102(b)[5]

The examiner has rejected these claims over either of Grinev or Bogdanova, two Chemical Abstracts, abstracting Russian language articles by Grinev et al. and Bogdanova et al.

For a reference to be anticipatory, it must describe, either expressly or under the principles of inherencey, each and every feature of the claimed invention. Verdegaal Bros. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987); RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Neither abstract appears to expressly describe a compound falling within the scope of rejected claims 1-6, 8-9, 13-17, or 31-36, and the examiner has not provided an explanation of how the other limitations of the claims are met

[5] The examiner's statement of the rejection also refers to claim 21. Examiner's Answer, p. 8. However, claim 21 has apparently been canceled.

by the abstracts. The examiner has also not explained how the abstracts expressly describe a compound which binds to a fusion protein required by claim 30. No evidence showing or reasoning explaining how the claimed subject matter is inherently described by the abstracts has been provided. We recognize that the Bogdanova abstract refers to aryl and alkyl analogs of p-benzoquinone and hydroquinone halides. We find this teaching ambiguous and the examiner has not provided an explanation of how the aryl or alkyl analogs meet the claim limitations. Thus, neither Bogdanova and Grinev describe an embodiment within the scope of the claimed subject matter.

While we are in effect reversing the examiner's rejection under § 102(b) based on the Grinev and Bogdanova abstracts, we note that the Russian language publications which were abstracted appear to be highly pertinent to the claimed subject matter. These publications are not of record in the application. The examiner has not indicated that the references are not available in the PTO or that attempts to obtain the articles through inter-library loan were unsuccessful. We therefore, vacate the rejection and remand the application to the jurisdiction of the examiner for further prosecution and consideration of the Bogdanova and Grinev articles.

The rejection of claims 1-6, 8-9, 12-17 and 23-26 under 35 U.S.C. § 103

The examiner has rejected these claims under 35 U.S.C. 103 as unpatentable over the combination of Leach et al., Grinev, Bogdanova, Thiel, Korsakova, Lyubchanskaya, Ordzhonikidze and Lavie. We vacate and remand this rejection also.

The examiner's answer relies on and discusses a Leach et al. reference. Examiner's Answer, p. 8. This reference, however, is not of record in the application, A copy of the reference is not present in the application file. Nor is it listed on the PTO Forms 852 and 1449 of record. Thus, we are unable to evaluate the teachings of the reference. In addition, the rejection relies on the meager descriptions of abstracts of foreign language publications. These publications appear highly relevant to the claimed subject

matter. The publications appear to be available through interlibrary loan. The state of the current record precludes us from evaluating this rejection.

Accordingly, we vacate the rejection of claims 1-6, 8-9, 12-17 and 23-26 under 35 U.S.C. § 103 and remand the application for further proceedings including properly including a copy of the Leach et al. reference and consideration of the full text of the abstracted articles.

New Ground of Rejection under 35 U.S.C. § 112, ¶ 2

Claims 31-33 are rejected under 35 U.S.C. § 112, ¶ 2, as indefinite. These claims are dependant on claims 1, 14 and 27, respectively. As such they are subject to the mandatory claim construction of of § 112, ¶ 4. That paragraph provides in part:

> A claim in dependent form shall be construed to incorporate by reference all limitations of the claim to which it refers.

Thus the limitation of claims 1, 14 and 27 must be read into claims 31-33. Each of claims 1, 14 and 27 requires that "OX^1 AND OX^2 are simultaneously hydroxy." Claims 31-33 each include the limitation "wherein one of OX^1 AND OX^2 is hydroxy and the other is OR^4 where R^4 is saturated or unsaturated hydrocarbon of less than four carbons." Thus, claims 31-33 are internally inconsistent in simultaneously requiring (1) that OX^1 and OX^2 both be hydroxy and (2) that only one of OX^1 and OX^2 be hydroxy and the other be OR^4. The inconsistency renders the subject matter of the claims 31-33 indefinite.

This decision contains a remand and a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review." In addition 37 CFR § 1.196(e) provides that a decision which includes or allows a remand is not final for purposes of judicial review.

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED-IN-PART, VACATED-IN-PART, REMANDED, 1.196(b)

JOHN D. SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
RICHARD E. SCHAFER	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
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